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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/612,386

07/02/2003

Claes Lindgren

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02/02/2007

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EXAMINER

A, PHI DIEU TRAN

ART UNIT

PAPER NUMBER

3637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/612,386

Applicant(s)

CLAES LINDGREN ET AL

Examiner

Phi D. A

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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In view of the appeal brief filed on 11/1/2006, PROSECUTION IS HEREBY REOPENED. The claims are rejected set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

A handwritten signature in black ink, appearing to read "Lanna Mae", with a long horizontal flourish extending to the right.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitations of “ the first arm,the third arm, the fourth arm,are more flexible thanthe rest of the second arm, the third finger....” Is not supported by the disclosure. The first arm, the third arm, the fourth arm appears to have the same cross sectional areas as those of the rest of the second arm, the third finger. If they are of the same cross section, they cannot have different flexibilities.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 5, 6-7, 10, 13, 20, 22-24, 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 preamble sets forth the curb being a subcombination with the skylight, the claim language “disposed to contact the upper surface of the curb” appears to claim the curb as a combination. If applicant is not claiming a curb, a gap between the frame and the curb, cannot exist. To claim a gap without claiming a curb is thus also indefinite. Furthermore, applicant’s

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use of “contactable, disposable, extendable” also confuses the scope of the claim as it is unclear whether applicant is actually claiming structures that “contact, dispose, or extend” thereof.

Claim 5 “contactable with the bottom of the skylight” is indefinite. Should it “contacting with the bottom surface of the light transmitting section”?

“a third and fourth arm” is indefinite as it is confusing. As there is no second arm, there cannot be a “third or/and a fourth arm”.

Claims 6-7 has problems with “curb” as set forth in claim 1 above.

Lines 1-2 “a fifth arm” is indefinite as it is confusing. As there is no second to fourth arms in the claim, there cannot be a “fifth arm”.

Claim 10 has similar problem as set forth in claim 5 above.

Claim 13 has problems with “curb” as set forth in claim 1 above.

Claim 13 “a gasket carried by the frame” is confusing. The gasket is disclosed as attached to the frame, not carried by the frame.

Claim 20 has problems with “curb” as set forth in claim 1 above.

Claim 22 has similar problem as set forth in claim 13 above.

Also claim 22 last paragraph last 3 “that the “ is indefinite.

Claim 23 appears to claim a subcombination between the gasket and the curb/skylight. The claim language “sealing the gap” appears to positively claim the skylight frame. It is thus indefinite.

Claim 23-24, 28-29 also have problem with claim language of “disposable, contactable” as it appears to confuse the scope of the claims.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23-27, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Oakley et al (4119325).

Oakley et al (figure 1) a sealing gasket comprising a main body portion (21, 25), a first arm (33) extending from the main body portion, the gasket having a second arm (27) extended from the main body portion, the first arm is more flexible than the main body portion (21, 25), the second arm having a tip (at 31) that is more flexible than the rest of the second arm (inherently so as the cross section is smaller), the gasket having a third and fourth arm (the flanges on both sides of part 21) extending from the main body portion, the third and fourth arm being more flexible than the main body portion (inherently so as the arms have smaller cross sectional area than the main body portion), certain portions of the gasket are more flexible than other portions of the gaskets.

3. Claims 23-27, 32 are rejected under 35 U.S.C. 102(a) as being anticipated by McMillin et al (6478308).

McMillin et al (figure 3) a sealing gasket comprising a main body portion (46, 42, 24), a first arm (30) extending from the main body portion, the gasket having a second arm (22) extended from the main body portion, the first arm is more flexible than the main body portion, the second arm having a tip (at 32) that is more flexible than the rest of the second arm

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(inherently so as the cross section is smaller), the gasket having a third and fourth arm (43, 45 21) extending from the main body portion, the third and fourth arm being more flexible than the main body portion, certain portions of the gasket are more flexible than other portions of the gaskets.

4. Claims 23, 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nolles et al (2002/0033581).

Nolles et al (figure 1) shows a sealing gasket comprising a main body portion (the area surrounding in the opening in the middle and not including arms 5), a first arm (5) extending from the main body portion, the gasket having a fifth arm (11) extending from the main body portion, the fifth arm having first and second fingers (15, and the other to one to the left) extending therefrom, the first and second fingers being more flexible than the rest of the fifth arm, the fifth arm having a third finger (the finger at 14) extending in a direction opposite from the second finger, the first and second fingers being more flexible than the third finger and the main body portion.

5. Claims 23, 24, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Trieste et al (4717162).

Trieste et al (figure1, 3) shows a sealing gasket comprising a main body portion (16, 18, 20, 14), a first arm (38, left) extending from the main body portion, a second arm (38 right) extending from the main body portion, the second arm having at least one drainage opening therethrough (the opening at 40 inherently can function as a drainage opening).

6. Claims 1, 3, 6, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Jentofet et al (4409767).

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Jentoft et al (figure 1-2) shows a skylight with sealing gasket (2), comprising a frame (58, 56) defining an interior opening, the frame including an inner side surface (the interior surface of 56) that will face an outer surface of a curb when the frame is installed thereupon so as to define a first gap therebetween, the frame also including a bottom surface (the interior surface of part 58) that will face an upper top surface of the curb when installed thereupon so as to define a second gap therebetween, at least one light transmitting section (16) disposed within the frame, a gasket (figure 2) disposable between the frame and the curb and between the light transmitting section and the curb, the gasket including a main body portion (48, 30, 25 and the vertical section next to channel 34), the main body portion disposed to contact the upper top surface of the curb and to contact the bottom surface of the light transmitting section and to extend across the second gap when the frame is installed upon the curb, the gasket also including a first arm (50) extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb, the first arm being more flexible than the main body portion, the gasket having a fifth arm (26 and the parts to the right side of channel 34) extending from the body portion and contactable with the upper top surface of the curb, certain portions of the gasket are more flexible than other portions of the gasket,

7. Claims 1, 2, 4-6, 9-10, 12, 13-14, 16-19, 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindgren et al (6640508).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

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CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Lindgren et al (figure 4) shows a skylight with sealing gasket, comprising a frame (109) defining an interior opening, the frame including an inner side surface that will face an outer surface of a curb when the frame is installed thereupon so as to define a first gap therebetween, the frame also including a bottom surface that will face an upper top surface of the curb when installed thereupon so as to define a second gap therebetween, at least one light transmitting section (110) disposed within the frame, a gasket disposable between the frame and the curb and between the light transmitting section and the curb, the gasket including a main body portion (the thick part touching the bottom of the pane and one of its attaching leg), the main body portion disposed to contact the upper top surface of the curb and to contact the bottom surface of the light transmitting section and to extend across the second gap when the frame is installed upon the curb, the gasket also including a first arm (the part extending across all the way to the right) extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb, the gasket having a second arm (138) extended from the main body portion, the second arm contacting the inner surface of the frame (per its right fins), the second arm having a tip (the fins) that is more flexible than the rest of the second arm, the gasket having a third and fourth arm extending from the main body portion and contactable with the bottom surface of the skylight, the third and fourth arm being more flexible than the main body portion, the gasket having a fifth arm extending from the main body portion and contactable with the upper top surface of the curb, the

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frame including an inward protrusion defining a lip, the second arm contacting the lip (112), the second arm is secured to the lip of the skylight (per the pressure contact), certain portions of the gasket are more flexible than other portions of the gasket.

8. Claims 1, 6, 12-13, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamura (5107646).

Tamura (figure 12a) shows a structure with sealing gasket (the structure inherently is able to function as a skylight as claimed), comprising a frame (7) defining an interior opening, the frame including an inner side surface (the interior surface of part 7a, 7) that will face an outer surface of a curb when the frame is installed thereupon so as to define a first gap therebetween, the frame also including a bottom surface (the interior surface of part 7b) that will face an upper top surface of the curb when installed thereupon so as to define a second gap therebetween, at least one light transmitting section (2) disposed within the frame, a gasket disposable between the frame and the curb and between the light transmitting section and the curb, the gasket including a main body portion (figure 12a, the part directly below part 4a), the main body portion disposed to contact the upper top surface of the curb and to contact the bottom surface of the light transmitting section and to extend across the second gap when the frame is installed upon the curb, the gasket also including a first arm (14a) extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb, a second arm extending from the main body portion and contacting the inner surface of the frame (the part next to the first arm).

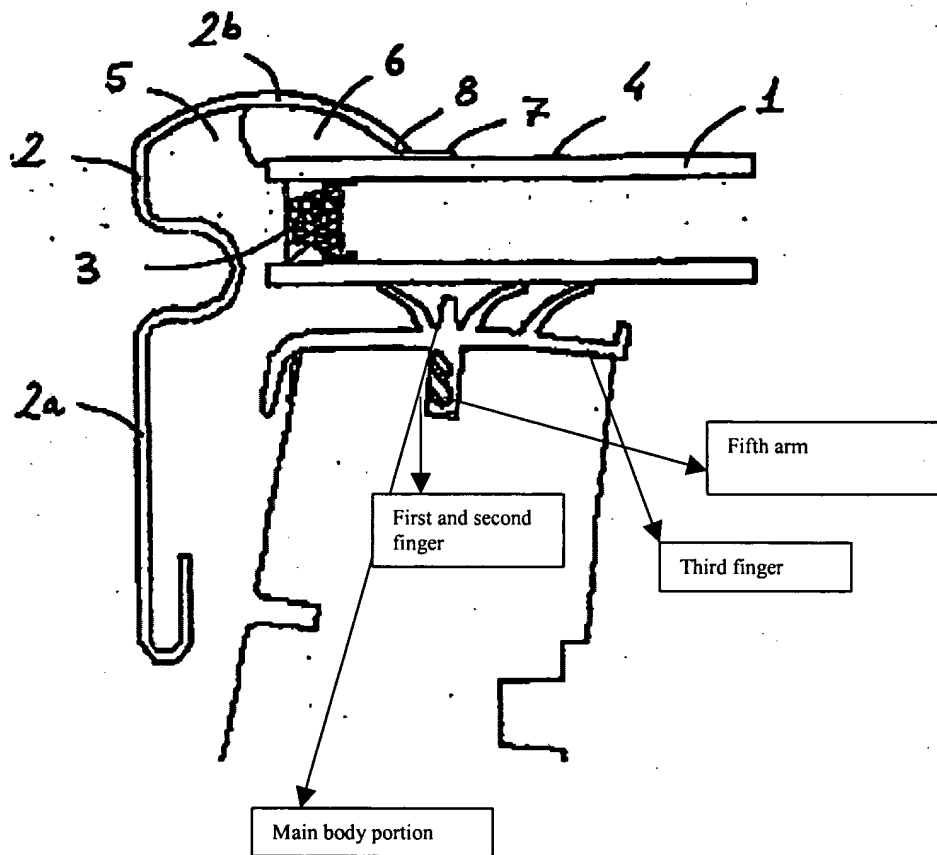
Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 7-8, 13, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al (2005/0126093) in view of Widmer (6418679).

Wagner (figure 1) shows a skylight with a sealing gasket comprising a frame (2) defining an interior opening, the frame including an inner side surface that will face an outer surface of a curb when the frame is installed thereupon so as to define a first gap therebetween, the frame also including a bottom surface that will face an upper top surface of the curb when installed thereupon so as to define a second gap therebetween, at least one light transmitting section (1, the two panes) disposed within the frame, a gasket disposable between the frame and the curb and between the light transmitting section and the curb, the gasket including a main body portion, the main body portion disposed to contact the upper top surface of the curb and to contact the bottom surface of the light transmitting section and to extend across the second gap when the frame is installed upon the curb, the gasket having a fifth arm extending from the main body portion and contactable with the upper top surface of the curb, the fifth arm having first and second fingers extending therefrom contactable with the upper top surface of the curb, the first and second fingers being more flexible than the rest of the fifth arm, a third finger extending in a direction opposite from the second finger, the first and second fingers are more flexible than the third finger and the main body portion,



Wagner does not show the gasket having a first arm extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb.

Widmer (figure 3) shows a first arm (42a) extendable across a first gap and contactable with the inner sides surface of a frame (9) when the frame is installed upon the curb.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wagner's structure to show the gasket having a first arm extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb because it would provide wind and moisture shield for the skylight as taught by Widmer.

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Per claims 2, 13, Wagner as modified shows all the claimed limitations except for a second arm extended from the main body portion, the second arm contacting the inner side surface of the frame.

Widmer further shows a second arm (42c) extended from the main body portion, the second arm contacting the inner side surface of the frame to further provide protection against wind and moisture.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wagner's modified structure to show the gasket having a second arm extending from the main body portion, the second arm contacting with the inner side surface of the frame because the second arm would provide further wind and moisture protection for the skylight as taught by Widmer.

5. Claims 1-2, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widmer (6418679) in view of Wagner et al (2005/0126093).

Widmer (figure 1) shows a skylight a with sealing gasket (10) a frame (9 and its other attaching part) including an inner side source surface (9) that will face an outer surface of a curb when the frame is installed thereupon so as to define a first gap therebetween, the frame also including a bottom surface that will face an upper top surface of the curb when installed thereupon so as to define a second gap therebetween, at least one light transmitting section (8) disposed within the frame, a gasket (10) disposable between the frame and the curb and between the light transmitting section and the curb, the gasket including a main body portion (figure 3, 33, 42d), the main body portion disposed to contact the upper top surface of the curb and to extend across the second gap when the frame is installed upon the curb, the gasket also including

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a first arm (42a) extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb, a second arm (42c) extending from the main body portion and contacting the inner surface of the frame.

Widmer does not show the main body portion disposed to contact the bottom surface of the light transmitting section.

Wagner et al shows a main body portion disposed to contact the bottom surface of the light transmitting section.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Widmer's structure to show the main body portion disposed to contact the bottom surface of the light transmitting section because it would allow for the good sealing between the skylight pane and the gasket as taught by Wagner et al.

6. Claims 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widmer (6418679) in view of Wagner et al (2005/0126093) as applied to claim 2 or 13 above and further in view of Wasserman (3034260).

Widmer as modified shows all the claimed limitations except for the second arm having at least on drainage opening therethrough.

Wasserman shows openings (34) in a sealing member to allow for drainage of water collecting within the skylight.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Widmer's modified structure to show the second arm having at least on

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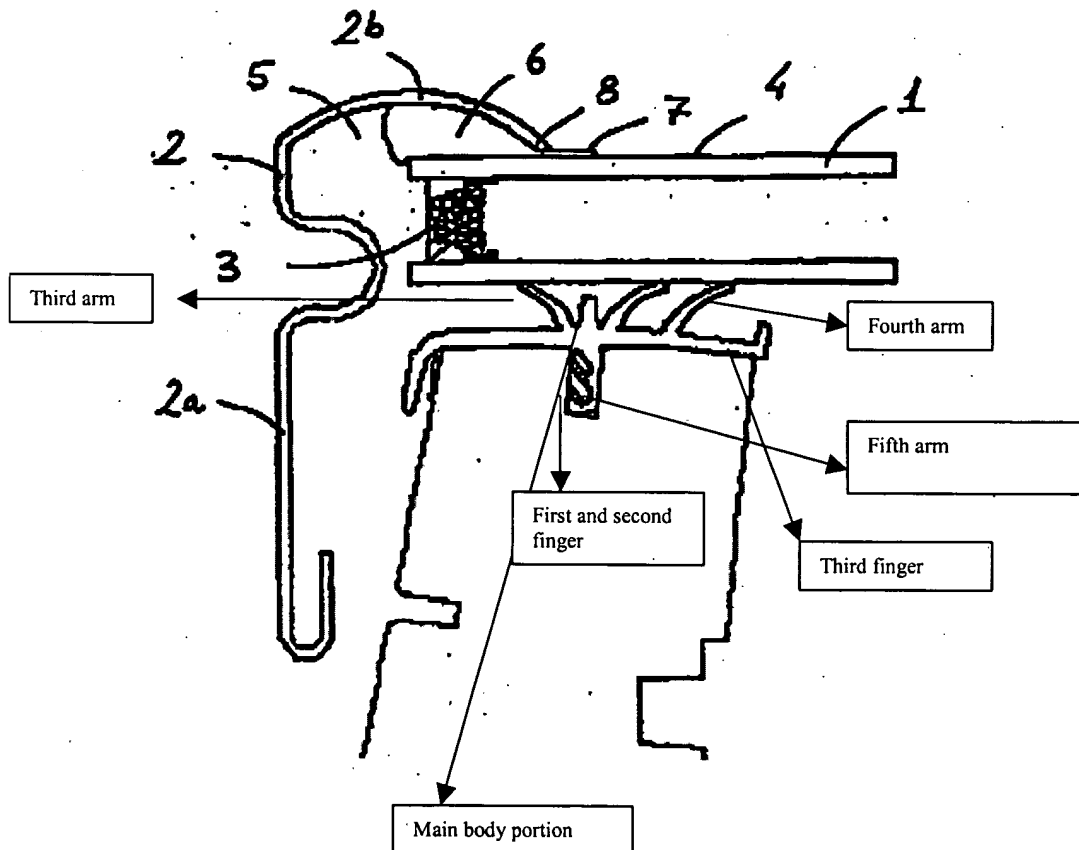
drainage opening therethrough because it would allow for the drainage of water from within the skylight as taught by Wasserman.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al (2005/0126093) in view of Widmer (6418679).

Wagner (figure 1) shows a skylight with a sealing gasket comprising a frame (2) defining an interior opening, the frame including an inner side surface that will face an outer surface of a curb when the frame is installed thereupon so as to define a first gap therebetween, the frame also including a bottom surface that will face an upper top surface of the curb when installed thereupon so as to define a second gap therebetween, the frame also including an inward protrusion (the part below part 2) defining a lip, at least one light transmitting section (1, the two panes) disposed within the frame, a gasket carried by the frame, the gasket disposable between the frame and the curb and between the light transmitting section and the curb, the gasket including a main body portion, the main body portion disposed to contact the upper top surface of the curb and to contact the bottom surface of the light transmitting section to define a weather resistant seal therewith and to extend across the second gap when the frame is installed upon the curb to define a weather resistant seal therewith, the gasket having a third and fourth arms extending from the main body portion and contacting the bottom surface of the light transmitting section, and fifth arm extending from the main body portion and has first and second fingers extending therefrom, the first and second fingers of the fifth arm contactable with the upper top surface of the curb, the fifth arm having a third finger extending in a direction opposite from the second finger, the first and second fingers of the fifth arm, the third arm, the fourth arm being

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more flexible than the rest of the fifth arm, the main body portion, the third finger of the fifth arm, and the rest of the fifth arm.



Wagner does not show the gasket having a first arm extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb to define a weather resistant seal thereto, a second arm extended from the main body portion, the second arm contacting the inner side surface of the frame to define a weather resistant seal therewith, the second arm contacting the lip.

Wagner further discloses arms having tips more flexible than the body portion of the arms.

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Widmer (figure 3) shows a first arm (42a) extendable across a first gap and contactable with the inner sides surface of a frame (9) when the frame is installed upon the curb.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wagner's structure to show the gasket having a first arm extending from the main body portion, the first arm extendable across the first gap and contactable with the inner side surface of the frame when the frame is installed upon the curb to define a weather resistant seal thereto, a second arm extended from the main body portion, the second arm contacting the inner side surface of the frame to define a weather resistant seal therewith, the second arm contacting the lip because having first and second arms would provide wind and moisture shield for the skylight as taught by Widmer, and having arms with tips more flexible than the rest of the arms would provide for easy elastic bending of the tip of the arms allowing for good sealing.

Wagner et al as modified shows the first arm, the tip of the second arm, the third arm, the fourth arm, the first finger of the fifth arm, the second finger of the fifth arm being more flexible than the main body portion, the rest of the second arm, the third finger of the fifth arm, and the rest of the fifth arm.

Response to Arguments

1. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different skylight structures and gasket designs.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

1/30/07

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

